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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/711,270	11/14/00	TRIVEDI	1M

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CHIRON CORPORATION
INTELLECTUAL PROPERTY R440
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EMERYVILLE CA 94662-8097

EXAMINER	
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ART UNIT	PAPER NUMBER
1646	

DATE MAILED: 05/11/00

Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/212,270	12/16/98	Tribouley	02441.77733

EXAMINER
Eileen B. O'Hara

ART UNIT	PAPER NUMBER
1646	13

DATE MAILED:

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

All claims are allowable. However, due to a potential interference, *ex parte* prosecution is SUSPENDED.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen B. O'Hara, whose telephone number is (703) 308-3312. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached at (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Eileen B. O'Hara, Ph.D

Eileen B. O'Hara 4/20/00

Patent Examiner

Lorraine Spector

LORRAINE SPECTOR
PRIMARY EXAMINER

DETAILED ACTION

1. Claims 1-16 are pending in the instant application.

Election/Restriction

2. Applicant is advised that claims 1-16 are each improper Markush claims because the five elements recited therein are proteins and nucleic acids which do not serve a common function which is based upon a common property or special techincal feature not found in the prior art. These proteins and nucleic acids are independent **and** distinct chemical compounds lacking either a common structural property which distinguishes them as a group from structurally related compounds of the prior art or which provides them with a common utility which is lacking from those prior art proteins. Therefore, restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-3, in so far as they are drawn to an isolated TNF-like protein comprising the amino acid sequence of SEQ ID NO: 1, classified in class 530, subclass 351.

II. Claims 1-3, in so far as they are drawn to an isolated TNF receptor-like protein comprising the amino acid sequence of SEQ ID NO: 2, classified in class 530, subclass 350.

III.. Claim 4, in so far as it is drawn to antibodies which specifically bind to a TNF-like protein comprising the amino acid sequence of SEQ ID NO: 1, classified in class 530, subclass 388.22.

IV. Claim 4, in so far as it is drawn to antibodies which specifically bind to a TNF

receptor-like protein comprising the amino acid sequence of SEQ ID NO: 2, classified in class 530, subclass 388.22.

V. Claims 5-12, in so far as they are drawn to a isolated polynucleotides encoding a TNF-like protein comprising the nucleotide sequence of SEQ ID NO: 6, classified in class 536, subclass 23.5

VI. Claims 5-12, in so far as they are drawn to a isolated polynucleotides encoding a TNF receptor-like protein comprising the nucleotide sequence of SEQ ID NO: 7, classified in class 536, subclass 23.5

VII. Claims 13-15, in so far as they are drawn to a method of screening for a compound capable of modulating cell death inducing activity by employing a TNF-like protein comprising the amino acid sequence of SEQ ID NO:1, classified in class 435, subclass 7.1.

VIII. Claims 13-15, in so far as they are drawn to a method of screening for a compound capable of modulating cell death inducing activity by employing a TNF receptor-like protein comprising the amino acid sequence of SEQ ID NO:2, classified in class 435, subclass 7.1.

IX. Claims 13-15, in so far as they are drawn to a method of screening for a compound capable of modulating cell death inducing activity by employing a TNF receptor-like protein comprising the amino acid sequence of SEQ ID NO:3, classified in class 435, subclass 7.1.

X. Claims 13-15, in so far as they are drawn to a method of screening for a compound capable of modulating cell death inducing activity by employing a TNF receptor-like protein comprising the amino acid sequence of SEQ ID NO:4, classified in class 435, subclass 7.1.

XI. Claims 13-15, in so far as they are drawn to a method of screening for a compound capable of modulating cell death inducing activity by employing a TNF-like protein comprising the amino acid sequence of SEQ ID NO:5, classified in class 435, subclass 7.1.

XII. Claim 16, in so far as is is drawn to a method of identifying a binding partner of a TNF-like protein comprising the amino acid sequence of SEQ ID NO:1 by using a binding assay, classified in class 436, subclass 501.

XIII. Claim 16, in so far as is is drawn to a method of identifying a binding partner of a TNF receptor-like protein comprising the amino acid sequence of SEQ ID NO:2 by using a binding assay, classified in class 436, subclass 501.

XIV. Claim 16, in so far as is is drawn to a method of identifying a binding partner of a TNF receptor-like protein comprising the amino acid sequence of SEQ ID NO:3 by using a binding assay, classified in class 436, subclass 501.

XV. Claim 16, in so far as is is drawn to a method of identifying a binding partner of a TNF receptor-like protein comprising the amino acid sequence of SEQ ID NO:4 by using a binding assay, classified in class 436, subclass 501.

XVI. Claim 16, in so far as is is drawn to a method of identifying a binding partner of a TNF-like protein comprising the amino acid sequence of SEQ ID NO:5 by using a binding assay, classified in class 436, subclass 501.

1. The inventions are distinct, each from the other because of the following reasons:

The proteins that are inventions I and II, the antibodies that are inventions III and IV, and the polynucleotides that are inventions V and VI are six structurally and functionally different chemical compounds each of which can be made and used without any one or more of the other compounds. Lack of unity is shown because these compounds lack a common utility which is based upon a common structural feature which has been identified as the basis for that common utility.

Inventions V and VI are related to inventions I and II as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polynucleotides of inventions V and VI can be used to recombinantly produce the proteins of inventions I and II, but they can also be used in a method of gene therapy, or as hybridization probes, which are both materially different methods from producing the protein.

Inventions I and II are also related to inventions III and IV as products and processes of use. The proteins of inventions I and II can be used in a method of making the antibodies of

inventions III and IV, but the antibodies can also be made using chemically synthesized peptide fragments.

Inventions I and II are related to each of inventions VII-XI and XII-XVI as products and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the proteins of inventions I and II can also be used therapeutically, which is a process materially different from that of inventions VII-XI and XII-XVI.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and would require a non-coextensive literature search, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen B. O'Hara, whose telephone number is (703) 308-3312. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell can be reached at (703) 308-4310.

Official papers filed by fax should be directed to (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

JOHN ULM
PRIMARY EXAMINER
GROUP 1800